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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/398,665	09/17/1999	KARL L. GINTER	7451.0005-01	1372

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EXAMINER
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DARROW, JUSTIN T

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/398,665

Applicant(s)

GINTER ET AL.

Examiner

Justin T. Darrow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2005 and 15 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 121-150 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 121-140 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-140 have been presented for examination. Claims 1-20 have been canceled and new claims 21-117 have been added in a preliminary amendment filed 09/17/1999. Claims 21-117 have been canceled and new claims 118-120 have been added in an amendment filed 02/27/2002. Claims 118-120 have been canceled and new claims 121-140 have been added in an amendment filed 07/28/2003. Claims 121, 134, and 136-139 have been amended and new claims 141-150 have been added in an amendment filed 04/15/2005. Claims 121-150 have been examined.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/15/2005 has been entered.

### ***Priority***

3. Acknowledgment is made that the instant application is a continuation of Application No. 08/699,712, filed 08/12/1996, now abandoned, which is a continuation-in-part of Application No. 08/388,107, filed 02/13/1995, now abandoned.

***Information Disclosure Statement***

4. The information disclosure statements (IDS) submitted on 04/06/2004 and 06/10/2005 was filed before the mailing date of the first Office action after filing a request for continued examination under 37 CFR 1.114 on 03/09/2005. The submission is in compliance with the provisions of 37 CFR 1.97(b)(4). Accordingly, the information disclosure statements are being considered by the examiner.

***Drawings***

5. The drawings were received on 03/09/2005. These drawings are approved.

***Response to Arguments***

6. Applicant's arguments, see Paper REM(03/09/2005), filed 03/09/2005, page 10, line 22-page 11, line 29), with respect to the rejections of claims 134-140 under 35 U.S.C. 102(e) based on Stefik, U.S. Patent No. 5,715,403 A have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new grounds of rejection is made in view of 35 U.S.C. 101.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 134-140 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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Claims 134-140 are drawn to a computer program product stored on a computer-readable medium. However, the term “computer program product” does not appear in the specification. “Dictionaries, ..., publicly available . . . are objective resources that serve as reliable sources of information on the established meanings that [are] attributed to the terms of the claims by those of ordinary skill in the art.” *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 64 USPQ2d 1812, 1818 (Fed. Cir. 2002) and MPEP § 2111.01 II. Here, the Microsoft Press Computer Dictionary, 3<sup>rd</sup> ed., defines “product” as software conceived and developed for commercial use (see page 383). Under this definition, a “computer program product” is a computer listing. “[C]omputer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical ‘things.’ They are neither computer components nor statutory processes, as they are not ‘acts’ being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the functionality of the computer to be realized.” MPEP § 2106 IV. B. 1(a). This rejection can be overcome by a claiming “computer-readable medium encoded with a computer program product.” *See id.*

#### ***Allowable Subject Matter***

9. Claims 121-133 and 141-150 are allowed.
10. The following is an examiner’s statement of reasons for allowance:

Claims 121-133 are drawn to a rights-management method. The closest prior art, Stefik, U.S. Patent No. 5,715,403 A, discloses a similar method. However, Stefik neither teaches nor suggests, in accordance with a control set associated with electronic content, automatically using

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at least one digital certificate associated with the user to select one of two or more alternative conditions for governing the access to or other use of the electronic content. This distinct step explicitly incorporated into independent claim 121 renders claims 121-133 allowable.

Claims 141-146 are drawn to a method. The closest prior art, Stefik, U.S. Patent No. 5,715,403 A, discloses a similar method. However, Stefik neither shows nor motivates, in accordance with a control set, including at least two controls for governing access to or other use of a piece of electronic content, where the control set specifies at least a first digital certificate or class of digital certificates required to make use of a first of the at least two controls, where the control set further specifies at least a second digital certificate or class of digital certificates required to make use of a second of the at least two controls, automatically using at least one digital certificate associated with the user to select between the first and second controls. This composite step incorporated into independent claim 141 renders claims 141-146 allowable.

Claims 147-150 are drawn to a method. The closest prior art, Stefik, U.S. Patent No. 5,715,403 A, discloses a similar method. However, Stefik neither shows nor implies using at least one digital certificate associated with a first user to automatically select a first price from two or more alternative prices for accessing or otherwise using electronic content. This particular step explicitly recited in independent claim 147 renders claims 147-150 allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

*Telephone Inquiry Contacts*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin T. Darrow whose telephone number is (571) 272-3801, and whose electronic mail address is justin.darrow@uspto.gov. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón, Jr., can be reached at (571) 272-3799.

The fax number for Formal or Official faxes to Technology Center 2100 is (703) 872-9306. In order for a formal paper transmitted by fax to be entered into the application file, the paper and/or fax cover sheet must be signed by a representative for the applicant. Faxed formal papers for application file entry, such as amendments adding claims, extensions of time, and statutory disclaimers for which fees must be charged before entry, must be transmitted with an authorization to charge a deposit account to cover such fees. It is also recommended that the cover sheet for the fax of a formal paper have printed "**OFFICIAL FAX**". Formal papers transmitted by fax usually require three business days for entry into the application file and consideration by the examiner. Formal or Official faxes including amendments after final rejection (37 CFR 1.116) should be submitted to (703) 872-9306 for expedited entry into the application file. It is further recommended that the cover sheet for the fax containing an amendment after final rejection have printed not only "**OFFICIAL FAX**" but also "**AMENDMENT AFTER FINAL**".

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

June 26, 2005



**JUSTIN T. DARROW  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 2100**